

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-14 are pending in the application, with claims 1, 3, 6 and 10 being the independent claims. No claims are sought to be cancelled. No new claims are sought to be added. Claim 1 is sought to be amended. This change is believed to introduce no new matter, and its entry is respectfully requested.

The Examiner is asked to enter and consider this amendment after final because it raises no new issues requiring further search and/or consideration, while also placing the application in better condition for allowance and/or appeal.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Rejection under 35 U.S.C. § 103

Claims 3-5 and 9-14 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Pat. No. 6,611,598 to Hayosh ("*Hayosh*"). Applicants respectfully traverse this rejection.

The Examiner failed to establish a prima facie case of obviousness because the Examiner has not properly considered all features recited in the claims, the Examiner improperly uses speculation instead of evidentiary support, and the Examiner improperly uses hindsight.

The Examiner asserts that the use of the words “adapted to” and “configured to” merely recite an intended use of an apparatus, that the *Hayosh* system is “capable of printing and verifying the hash value containing in the MICR line of a check,” and that “it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Hayosh’s to include the feature above for the purpose of enhancing the security in processing a check”. *See Office Action at pp. 3-4.*

Applicants have carefully considered Examiner’s assertions, but respectfully disagree for the following reasons.

Applicants do not agree that the pending claims “merely recite an intended use,” as alleged by the Examiner. Rather, Applicants remind the Examiner that “[a] functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art.” *See M.P.E.P. § 2173.05(g).* “A functional limitation is often used ... to define a particular capability or purpose that is served by the recited element.” *Id.* Here, “adapted to receive checks,” “adapted to print,” “adapted to verify checks,” “configured to receive information” and “configured to access,” as recited in the pending claims, do not recite a “new intended use” as alleged in the Office Action, but “a particular capability or purpose that is served by the [respective] recited element[s].” Accordingly, Applicants submit that the rejection of claims 3-5 and 9-14 should be withdrawn.

Also, Applicants respectfully submit that the Examiner’s assertions regarding *Hayosh* improperly and impermissibly go beyond the disclosure of *Hayosh*, and therefore find their basis only in speculation, rather than in any evidence of record. Specifically, the Examiner asserts “it would have been obvious to one with ordinary skill

in the art at the time the invention was made to modify Hayosh's to include the feature above for the purpose of enhancing the security in processing a check." *See Office Action at p. 4.* However, nowhere in *Hayosh* is there any teaching or suggestion that supports such a bare assertion. Moreover, as M.P.E.P. § 2144.03(a) notes "[i]t is never appropriate to rely solely on "common knowledge" in the art without **evidentiary support in the record**, as the principal evidence upon which a rejection was based." (*emphasis added*). Accordingly, in the absence of any teaching or suggestion in the reference of record, or from other evidentiary support in the record, Applicants respectfully request that the rejection of claims 3-5 and 9-14 be withdrawn.

Further, the Examiner uses impermissible hindsight when asserting "it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Hayosh's to include the feature above for the purpose of enhancing the security in processing a check." *See Office Action at p. 4.* As noted above, nowhere in *Hayosh*, or in any evidentiary record, is there any teaching or suggestion that supports such a bare assertion. Accordingly, Applicants contend that one of ordinary skill in the art would not arrive at the Examiner's asserted teaching, without the benefit of the disclosure in the current Application. Applicants respectfully remind the Examiner that, when applying 35 U.S.C. § 103(a), taking advantage of hindsight afforded by the claims to view the references is impermissible. *M.P.E.P. § 2142.* Accordingly, on this additional basis, Applicants respectfully request that the rejection of claims 3-5 and 9-14 be withdrawn.

Therefore, because the Examiner has not properly considered all features recited in the claims, improperly uses speculation instead of evidentiary support, and the

Examiner improperly uses hindsight, the Examiner has failed to establish a prima facie case of obviousness, and the rejection should be withdrawn.

Allowable Subject Matter

Applicants acknowledge with appreciation the Examiner's indication that claims 1, 2 and 6-8 contain allowable subject matter.

Other Matters

Applicants acknowledge with appreciation the Examiner's suggestion to avoid the alleged "intended use" issue in the claim language (suggesting e.g., "a receiver receiving checks"). *See Office Action at p. 4.* However, Applicants decline to make such amendments at this time, based on the arguments noted-above.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

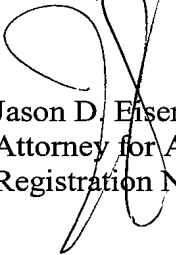
Reply to Office Action of November 26, 2008

Meadow *et al.*
Appl. No. 09/901,124

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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